

Remarks

Applicant respectfully traverses the restriction and requests reconsideration in view of the amendment above and these remarks.

Applicant provisionally elects group 1, claims 1-15 and 26 for examination.

Applicant provisionally elects the species of Zinc Sulfide. However, this issue is moot in view of the above claim amendments removing the group consisting of zinc sulfide (ZnS), barium sulfide (BaS), alkyl sulfonate, and thioester. Applicant makes this amendment without prejudice and preserves the right to pursue claims to the species.

Applicant respectfully traverses the restriction for the following reasons.

There is not a serious search burden on the Examiner, especially considering the amendment consolidating species identified by the Examiner. The claims share common elements, and thus, the search for one group of claims is going to be usable for another group of claims due to the overlap of these common elements. This point is further evidenced by the Office's examination of related application 10/677,092, in which no restriction was required despite the existence of claims directed to compositions, articles, identification documents and methods.

With respect to reliance on MPEP Section 806.05(f), the Office has not established two-way distinctiveness among groups I, II, and IV. The Examiner contends that the "intermediate product is deemed to be useful as making a bank card, drivers license, passport, credit card, smart cards, etc." This example does not differentiate groups I, II, IV because the composition, article and identification documents are all potentially useful as making a bank card, drivers license, passport, credit card, smart cards, etc.

MPEP Section 806.05(f) requires the following criteria to establish that the inventions are distinct:

- (A) the inventions as claimed do not overlap in scope, i.e., are mutually exclusive;
- (B) the inventions as claimed are not obvious variants; and
- (C) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect.

While Applicant has noted that the claims have common elements, Applicant does not take a position on criteria A and B of MPEP Section 806.05(f) at this time because C

is not met. Regarding C, the composition, article and identification document are clearly capable of use together as evidenced by the Examiner's example. In particular, they are all usable together in identification documents. Further, under the guidelines of MPEP Section 802.01, these related inventions are connected in at least one of design, operation or effect. In particular, these inventions share common composition elements.

In order to maintain this restriction, the Office must establish two-way distinctiveness among the inventions (i.e., the inventions are patentable over each other).

Regarding the product and process claims, Applicant requests the Examiner to reconsider the restriction on the ground that it would not be burdensome to search these related inventions together. These claims have common elements, and the Office has already demonstrated the ability to search method and product claims together in related application 10/677,092 as noted above. Therefore, it should be appropriate in this application as well.

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Respectfully submitted,

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